

REMARKS

The Office Action of May 24, 2007 presents the examination of claims 8-10, 17 and 20. Claims 11-13, 18 and 19 are withdrawn. Claims 22-25 are newly added.

Support for new claims

New claims 22 and 24 find support in the specification at least at page 50, line 24 and from the experimental data in Table 9. New claims 23 and 25 find support in the specification at least at page 52, lines 14-16.

Rejection over Wu

Claims 8-10, 17 and 20 stand rejected under 35 USC § 102(e) as anticipated by Wu et al. '415. This rejection is respectfully traversed. Reconsideration and withdrawal thereof are requested.

For a reference to be anticipating, there must be particularized disclosure of the specific compound or genus claimed. It is not sufficient that the compound of an application can be assembled from generic disclosure of each of the possible groups appended to a structure. See, e.g. *In re Petering*, 133 USPQ 275 (CCPA 1962); *In re Ruschig*, 145 USPQ 274 (CCPA 1965).

The instant claim 8 recites:

A compound that is a derivative of dextromethorphan having the nitrogen-bound methyl group substituted by a C₁ to C₆ alkyl group having a hydrogen-bond accepting group. The elected species for present examination further limits that structure to those that are a nitrogen-containing heterocyclic group.

Wu et al. '415 disclose derivatives and analogs of morphine. The reference describes at least four distinct core structures (formulae I, II, III and IV). Furthermore, each of those core structures is disclosed as derivatized at either of two positions (R and X). Eleven fundamental possibilities are given for R (see paragraph 22), six of which include a further substituent having a "ring", which ring is further defined only by examples of three fundamentals, each of which

can be “substituted” by myriad possibilities. The possibilities for X go on for two full paragraphs. (See, paragraphs 24-25.) Therefore, Wu ‘415 discloses hundreds, if not thousands or tens of thousands, of compounds. There is no disclosure in Wu ‘415 specifically pointing the artisan to dextromethorphan derivatives having the amino methyl group replaced by a nitrogen-containing heterocyclic group. Furthermore, Wu ‘415 seeks morphine antagonists, not non-competitive inhibitors of a ligand-gated neurotransmitter receptor. Thus, Wu ‘415 fails to urge either the particular structure of the compounds of the present invention or the function of such compounds.

Disclosure of any particular dextromethorphan derivative having a heterocyclic amine at the nitrogen atom is not provided in the priority application. Therefore, such disclosure is not entitled to the priority date of May 17, 2002, but at the earliest, the PCT filing date of May 16, 2003. This is after the priority date claimed for the present application of April 11, 2003. Applicants note that support for the present claim 8 (and the current generic claim 11) is provided in the parent application at least at page 19, line 14 to page 20, line 3.

As there is no particular urging of the artisan toward the present invention by Wu ‘415, the rejection of claims 8-10, 17 and 20 as anticipated by the reference must be withdrawn.

Rejection over Grussner

Claims 8, 9 and 17 are rejected under 35 USC § 102(b) over Grussner ‘147. This rejection is respectfully traversed. Reconsideration and withdrawal thereof are requested.

At the very least, Grussner ‘147 does not disclose dextromethorphan derivatives; the 3 carbon is substituted by a hydroxyl, not a methoxyl, group. Therefore, Grussner ‘147 does not anticipate the present claims and the instant rejection must be withdrawn.

Certainly Grussner ‘147 is silent about the functionality of the compound as a non-competitive inhibitor of a ligand-gated ion channel receptor, and so at least claims 22-25 and the generic claim 11 (withdrawn) and claims dependent thereon should be free of this rejection.

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Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Mark Nuell, Registration No 36,623 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

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Respectfully submitted,

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